



REMARKS

Claims 1, 3 and 5-52 are all the claims pending in the application. Claims 1, 3 and 5-52 have been rejected under 35 U.S.C. § 103(a). Claim 40 has been rejected under 35 U.S.C. § 101.

AMENDMENTS TO THE CLAIMS

Claim 40 has been amended as shown above.

REJECTION UNDER 35 U.S.C. § 101

Claim 40 recites a cartridge recovery *method*. The Examiner asserts that because no structural limitations are provided (i.e., computer implementation), the claimed subject matter fails outside of the scope of the technological arts. However, under 35 U.S.C. § 101, “any new and useful process” is patentable. The method of 40 falls within the technological arts. Therefore, Applicant submits that the Examiner’s rejection of claim 40 is improper.

REJECTION UNDER 35 U.S.C. § 103(a)

A. Claims 1, 3, 41-44 and 47-52

Claims 1, 3, 41-44 and 47-52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,039,430 to Helterline et al. (“Helterline”) in view of U.S. Patent No. 6,629,134 to Hayward et al. (“Hayward”).

In rejecting the claims, the Examiner asserts that Helterline teaches “a reading component for reading information from the memory element (see column 8, lines 29-65); and an executing component for executing processing for providing a benefit to a user based on information read by the component (see column 8, lines 29-65). The Examiner acknowledges that Helterline fails to teach “wherein the information read is one of user support information, for supporting use of the image-forming apparatus and a URL of a site, on a communications network, possessing the

user support information; and the executing component executes processing for supporting the user based on the read information.” To overcome this deficiency, the Examiner relies on the teachings of Hayward. The Examiner contends that Hayward teaches “a system that detects computers’ peripherals conditions and provides user support based upon said detection (see column 6, lines 20-57). The Examiner then argues that it would have been obvious “to know that Helterline would transmit to a remote server computers peripheral conditions to determine the necessary users support information, as taught by Hayward. In this way the information provided is not only specific to the production configuration of the peripheral as it exists in the product’s life cycle, but also specific to the peripheral condition sensed.” For at least the following reasons, Applicant respectfully traverses the Examiner’s rejection.

With respect to claim 1, the claimed image-forming system comprises both the reading component and the executing component.

Helterline teaches that

the replaceable printing component 14 is inserted into a reading device that reads this non-operational information from the electrical storage device 38 associated with the replaceable printing component 14. This information is then used to collect various kinds of statistical data such as marketing data. Alternatively, a suitable port may be provided on the printing system 10 so that this non-operational information within the electrical storage device 38 can be passed to a suitable information collection device such as a computer or microprocessor based information collection device. For example, the printing system 10 may be connected to a network either directly or indirectly such as the internet. This non-operational information can be passed to a remote collection site on the network. Alternatively, a link such as a modem or radio frequency (RF) link or optical link may be used to pass this non-operational information from the printing system 10 to a suitable collection device.

Col. 8, lines 29-46. There is no teaching that the disclosed reading device is part of an image-forming apparatus. Indeed, Helterline’s usage of the term reading device indicates that such a

reading device is separate from Helterline's printing system 10. Alternatively, Helterline teaches that the information contained in electrical storage device 38 can be passed to a remote collection site on a network. Thus, the alternative embodiment also fails to teach or suggest an image-forming apparatus comprising a reading component and an executing component. Hayward fails to cure this deficiency.

Further, the Hayward reference fails to teach or suggest reading user support information from a removable cartridge's memory element. Hayward teaches a system for downloading user support information from a server based on a peripheral indicia read from an installed peripheral. See Abstract. Hayward does not teach or suggest reading user support information from any memory portion of the peripheral. Therefore, Applicant submits that even combined as the Examiner asserts, the combination of Helterline and Hayward fails to teach or suggest each element of claim 1.

As independent claim 3 recites similar limitations, Applicant submits that this claim is patentable over the combination of Helterline and Hayward for analogous reasons.

With respect to claim 41, the Examiner asserts that Helterline teaches "a step wherein the client uses information stored in the memory element to connect to the information-providing server or to gain access to information thereon," citing as support column 8, lines 29-45. However, nothing in Helterline teaches using information contained in Helterline's electrical storage device 38 to connect to an information-providing server. Helterline teaches that information may be passed from an electrical storage device to a remote server -- Helterline is absent a teaching that the contents of its electrical storage device 38 are used to access this server. See column 8, lines 29-45. Hayward fails to cure this deficiency. For at least this

reason, Applicant submits that independent claim 41 and dependent claims 42-44 are patentable over the combination of Helterline and Hayward. As the rejection of claims 47-52 is based upon the rejection of claim 41, Applicant submits that these rejections must also fail. Further, as claims 47-52 have a different scope than claim 41, Applicant submits that the Examiner's reliance on the rejection of claim 41 in support of the rejections of claims 47-52 is insufficient to establish the *prima facie* case of obviousness.

B. Claims 5-36

Claims 5-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Helterline in view of U.S. Patent No. 6,405,214 to Meade ("Meade") in further view of U.S. Patent No. 6,061,660 to Eggleston ("Eggleston").

Regarding claim 11, Applicant submits that, even if combined as asserted, the combined references fail to teach or suggest a system as recited in claim 11. The Examiner acknowledges that Helterline fails to teach an image-forming system comprising "a component that determines whether something has been won...and reads the prize data from memory." To overcome this deficiency, the Examiner relies on Meade and Eggleston to suggest various systems for awarding points based on a user's actual printing profile. However, what is absent from such teachings is a component (which is part of an image-forming system) that determines whether something has been won. The Examiner has not provided any indication of where such structure is taught in either Meade or Eggleston or the combination of the two references. Indeed there is no teaching of such structure. For at least this reason, Applicant submits that independent claim 11 and claims 12 and 16, which depend therefrom, are patentable over the cited art. As independent claim 5 and claims 6-10 and 16 which depend therefrom recite similar structure, Applicant

submits that they are patentable over the cited art. Claims 13-36 are similarly patentable over the cited art for analogous reasons.

C. Claims 37-40

Claims 37-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Helterline in view of Meade.

The Examiner argues that the Meade reference teaches using a printing profile to awarded prizes, citing column 5, lines 5-20. The Meade reference, however, is directed toward a system for allowing a client computer to receive “cookies” from a primary server, edit the information contained therein and send the cookie to a third-party server. See Fig. 3. Nothing in Meade teaches or suggest writing anything to a memory element of a cartridge of an image-forming apparatus. As the Examiner acknowledges, Helterline fails to teach or suggest this element. Therefore, Applicant submits that independent claims 37 is patentable over the cited art. As the Examiner relies on the rejection of claim 37 in support of his rejection of independent claims 38-40, Applicant respectfully submits that these rejections must also fail.

D. Claims 45-46


Claims 45-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Helterline in view of Meade in further view of Hayward. As claim 45 depends on claims 41-44 and as claim 46 depends on claim 41, and as the addition of the Hayward reference fails to cure the deficiencies of Helterline and Meade discussed above with respect to claims 41-44, Applicant submits that claims 45-46 are patentable over the cited art.

CONCLUSION

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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